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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,976	09/15/2003	Steven Lynch	DIIF-P01-001	2258
28120 7590 08/24/2007 FISH & NEAVE IP GROUP ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			EXAMINER MISIASZEK, MICHAEL	
			ART UNIT 3625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/662,976

Applicant(s)

LYNCH ET AL.

Examiner

Michael Misiaszek

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 8-19 and 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendments filed 5/18/2007 have been received and reviewed. The status of the claims is as follows:

Claims 1-29 are pending. Claims 8-19 and 25-29 have been withdrawn from consideration by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 5-7, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmoft in view of Mobley and Yates et al. (US 20010040551 A1, hereinafter Yates).

Regarding Claim 1

Emmofit discloses a communication device distributed to a user, the device comprising:

- an enclosure or support (at least abstract: housing)
- a wireless transmitter disposed in or on the housing or support and capable of transmitting in response to the solicitation data via a wireless communication channel (at least figure 1: antenna)
- an activation button to activate the device in at least two response modes, wherein the response modes are preprogrammed in the device (at least column 3, lines 12-18: biometric activation allows user to enable device for a number of operating options)

Emmofit does not disclose utilizing an electronic communication device in a solicitation. Mobley teaches that it is known to include an electronic communication device in a solicitation (at least abstract) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the communication device, as taught by Emmofit, with the use in a solicitation, as taught by Mobley, since such a modification would have provided decrease burden for a soliciting body in individual customer contact (at least paragraph [0002] of Mobley).

Emmofit further does not disclose at least two activation buttons, wherein each activation button activates the device in a response mode. Yates teaches that it is known to include multiple activation buttons for activating a communication device in multiple response modes (at least abstract) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the communication device, as taught by Emmofit, with the multiple activation buttons, as taught by Yates, since such a modification would have provided increased operational versatility in a handheld device (at least paragraph [0012] of Yates).

The Examiner notes that the recitation regarding the response modes does not affect the patentability of the structure of the communication device. Since the prior art contains all of the claimed structural elements of the apparatus, it meets the claim.

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Regarding Claims 2, 3, 5-7

Emmofft discloses:

- a data input device for entering data corresponding to an response mode (at least column , lines 20-35: user selections option for mode of operation)
- a display that displays a prompt to a user or data entered by the user in response to the prompt, or both (at least column 5, lines 1-13: display prompts user to enter voice data)
- a receiver adapted to receive data over the wireless communication channel (at least abstract: communications facility adapted to receive data)
- a stored electronic identifier identifying a provider distributing the solicitation (at least column 4, lines 20-34 and column 5, lines 14-36: stored identifier allows identification of device and provider)
- the enclosure or support comprises an envelope, a package or a two-dimensional support structure (at least abstract, figure 1: housing is a case or package)

Regarding Claims 20-22

Emmofit discloses a method for eliciting an electronic response from a customer through an electronic device, comprising:

- activating the electronic device for communication via a wireless communication channel (at least column 3, lines 12-18: user recognition activates device)
- selecting a response mode of the device (at least column 3, lines 19-35: user selects option for operation)
- transmitting said response mode to a provider (at least column 3, lines 36-56: user option transmitted to provider)
- receiving via the communication channel or a separate communication path a response from the provider conforming to the selected response mode (at least column 4, lines 1-19: data display corresponding to selected option)
- displaying the response from the provider and entering customer information in response to a displayed response (at least column 4, lines 1-19: data display corresponding to selected option; user can enter data relevant to option selected)
- transmitting via the wireless communication channel customer information to the provider conforming to the selected response mode (at least column 5, lines 29-36: relevant personal information transmitted)

Emmofit does not disclose utilizing an electronic communication device in a solicitation. Mobley teaches that it is known to include an electronic communication device in a solicitation (at least abstract) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method for eliciting an electronic response, as taught by Emmofit, with the use of an electronic communication device in a solicitation, as taught by Mobley, since such a modification would have provided decrease burden for a soliciting body in individual customer contact (at least paragraph [0002] of Mobley).

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2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Emmoft in view of Mobley and Yates as applied to claims 1-3, 5-7, and 20-22 above, and further in view of Cargin.

The combination of Emmoft, Mobley, and Yates discloses the claimed invention except for:

- a removable activation strip to activate the device

Cargin teaches that it is known to include a removable activation strip to activate a portable communication device (at least paragraph [0092]: non-conductive strip removed to allow device activation) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the communication device, as taught by Emmoft, Mobley, and Yates, with the removable activation strip, as taught by Cargin, since such a modification would have provided improved avoidance of electrostatic discharge in a portable device (at least paragraph [0055] of Cargin).

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3. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Emmoft in view of Mobley and Yates as applied to claims 1-3, 5-7, and 20-22 above, and further in view of Aufricht.

The combination of Emmoft, Mobley, and Yates discloses the claimed invention except for:

- the customer information includes a telephone number or an email address of the customer

Aufricht teaches that it is known to include transmitting an email address to a provider (at least paragraph [0192]: email address transmitted to advertiser) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method for eliciting an electronic response, as taught by Emmoft, Mobley, and Yates, with the transmitting of an email address, as taught by Aufricht, since such a modification would have provided more efficient user-advertiser interaction (at least paragraph [0191] of Aufricht).

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3. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Emmoft in view of Mobley and Yates as applied to claims 1-3, 5-7, and 20-22 above, and further in view of Deguchi.

The combination of Emmoft, Mobley, and Yates discloses the claimed invention except for:

- the displayed response includes at least one of a savings code and an activation code.

Deguchi teaches that it is known to include displaying a savings code (at least paragraph [0077]: promotion code displayed to customer) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method for eliciting an electronic response, as taught by Emmoft, Mobley, and Yates, with the displaying of a savings code, as taught by Deguchi, since such a modification would have provided discount information to customers conveniently (at least paragraph [0006] of Deguchi).

Response to Arguments

Applicant's arguments with respect to claims 1-7 and 20-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Misiaszek whose telephone number is (571) 272-6961. The examiner can normally be reached on 8:00 AM - 4:30 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael A. Misiaszek
Patent Examiner
8/18/2007


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